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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,293	05/31/2001	G. Eric Engstrom	112076-138338	2368
25943	7590	08/03/2005	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			THEIN, MARIA TERESA T	
		ART UNIT		PAPER NUMBER
				3627

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,293	ENGSTROM, G. ERIC	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 February 2005 and 18 May 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2005 has been entered.

Response to Amendment

Applicant's "Response to Notice of Non-Responsive Amendment" filed on May 18, 2005 and the "Amendment Accompanying for Request for Continued Examination" filed on February 18, 2005 have been considered with the following effect.

Applicant's response by virtue of amendment to claims 1-14 has overcome the Examiner's rejection of such claims under 35 USC 101.

Claims 1, 15, and 22 are amended. New claims 29-37 are added. Claims 1-37 remain pending in this application and an action on the merits of these claims follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 7-8, 10-16, 19-23, 26-30, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. in view of U.S. Patent Application No. 2001/0044785 to Stolfo et al.

Regarding claims 1, 15, 22, and 29, O'Donnell discloses an electronic delivery address service method, storage medium, an apparatus, and system comprising:

- the receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber (see at least paragraphs 11-12; 26; 92; 108; 125-127; 130; 132);
- in response, the delivery address service the electronically generating the subscriber with a substitute delivery address (see at least paragraphs 29; 55; 108; 139; 158; 262);
- the receiving by the delivery address service an electronic notification of either a request to deliver or an arrival of the purchased goods in an online purchase of the goods (see at least paragraphs 11-12; 26; 37; 87); and
- the intervening by the delivery address service by electronically communicating the provided mailing address of the subscriber to the delivery service to facilitate delivery of the purchased goods to the subscriber (see at least see at least paragraphs 11-12; 26; 87-88; 92; 108; 125-127; 130; 139).

However, O'Donnell does not explicitly disclose transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to

use in an online purchase of a good. O'Donnell discloses an anonymous shipping services by concealing the identity of the purchaser or the recipient of goods, products, and/or services. The user can make a purchase of goods, products/ and/or services, and arrange for the anonymous shipment of the goods so as to conceal the user's identify and shipment address from the provider (paragraph 253). The user database contains subscription information, subscriber information and membership information (paragraph 177).

Stolfo, on the other hand, teaches the transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good (paragraph 27; paragraphs 29-30; paragraphs 40-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, medium, apparatus, and system to O'Donnell, to include the transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good, as taught by Stolfo, in order to allow a user to securely order (Stolfo, paragraph 2).

Regarding claims 2, 16, 23, and 30, O'Donnell discloses the correlation of the substitute delivery address to the mailing address of the subscriber (see at least paragraphs 29; 55; 139).

Regarding claims 7-8, 19-20, 26-27, and 34-35, O'Donnell discloses wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service (see at least abstract; paragraphs

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139; 158); the receiving of a notification of a request to deliver a purchased good from a delivery service, and the providing the mailing address of the subscriber to the delivery deliver service (see at least paragraphs 17; 134-135; 158; 265).

Regarding claims 9 and 36, O'Donnell and Stolfo substantially discloses the claimed invention, specifically, the delivery address service providing the mailing address of the subscriber to the delivery service (O'Donnell, see at least paragraphs 265-267).

However, the combination does not explicitly disclose the automatically providing of the mailing address of the subscriber to the delivery address. It was known at the time of the invention that merely providing an automatic means of providing the mailing address to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In other words there is no enhancement found in the claim recited. The end result is the same as compared to the manual activity.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to automatically provide the mailing address without requiring the delivery address service to explicitly request since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same request is not sufficient to distinguish over the prior art.

Regarding claims 10-12, 21, 28, and 37, O'Donnell discloses the receiving a confirmation by the deliver address service of the purchase (see at least paragraph 33; 71; 137; 264); wherein the delivery address service receives the confirmation form the

subscriber (see at least paragraph 33; 71; 137; 264); and receives the confirmation from an online business from which the goods to be delivered was purchased (see at least paragraph 33; 71; 137; 264).

Regarding claims 13-14, O'Donnell discloses the subscriber is a purchaser of the goods; or a beneficiary of the purchaser (see at least paragraph 90).

Claims 3-6, 17-18, 24-25, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. and U.S. Patent Application No. 2001/0044785 to Stolfo et al. as applied to claims 1, 15, 22, and 29 above, and further in view of U.S. Patent Application No. 6,336,100 to Yamada. O'Donnell and Stolfo substantially discloses the claimed invention, however, the combination does not explicitly disclose the mailboxes and the mailbox proximately located with the mailing address of the subscriber. The combination discloses the method and apparatus for providing anonymous shipping services (O'Donnell, paragraph 2). The combination discloses the apparatus includes one or more shipping service provider computer and one or more third party shipping service provider computers (O'Donnell, paragraphs 17 and 19). The shipper can be carrier, delivery service provider, shipping service provider, and transporter (O'Donnell, paragraph 92). The third party shipper can be third party carrier, third party shipping service provider, third party delivery service provider, etc (O'Donnell, paragraph 94). Furthermore, the combination discloses tracking information which include name of shipping party and address information, name of receiving party and the address information, etc. (O'Donnell, paragraph 202).

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Yamada, on the other hand, teaches the mailboxes and the mailbox proximately located with the mailing address of subscriber (col. 1, lines 11-15; col. 1, lines 22-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the mailbox the mailbox proximately located with the mailing address of subscriber, as taught by Yamada, so as to provide a place that is most convenient for the customer (Yamada, col. 6, lines 10-31).

Response to Arguments

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application No. 2001/0029496 to Otto et al. discloses a method and apparatus for anonymous purchasing wherein the goods are delivered anonymously.

U.S. Patent Application No. 2002/0022967 to Ohkado discloses an anonymous goods delivery method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
August 1, 2005

James S. McClellan
JAMES MCCLELLAN
PRIMARY EXAMINER